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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,937	09/12/2003	Robert M. Gorday	PT03585U	7030
20280	7590	03/18/2008		
MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER DUONG, FRANK	
			ART UNIT 2616	PAPER NUMBER
			NOTIFICATION DATE 03/18/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/660,937	<b>Applicant(s)</b> GORDAY ET AL.	
	<b>Examiner</b> Frank Duong	<b>Art Unit</b> 2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-29, 31-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5-14,29,31-35,39 and 40 is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☒ Claim(s) 37 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is a response to communications dated 12/07/07. Claims 1, 3, 5-29, 31-35 and 37-40 are pending in the application.

#### ***Claim Objections***

2. Claims 37-38 are objected to because of the following informalities: Claim 37 depends from cancelled claim 36 and claim 38 depends on claim 37. Thus, they are deemed to be improper dependent claims. Perhaps, in a response to this Office Action, Applicants should amend claim 37 to depend on claim 29 to remedy the aforementioned problem. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 19-28, there is no support for the claimed limitation of "wherein the controller is further configured to determined an indication ... the text format selection,"

in the original specification. Group claims 19-28 direct to network controller 110 of Figure 1 and its functionalities. However, the aforementioned limitation, as described on page 10, last paragraph of the original specification, refers to the functionality of the controller 220 in the mobile device.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al (USP 5,742,905) (hereinafter “Pepe”).

*(Note: Due to the problem discussed in the 112, first paragraph rejection, the newly added limitation is not considered and the rejection of claims 19-28 per last Office Action is maintained and as following)*

As per **claim 19**, in accordance with Pepe reference entirety, Pepe shows a system for the selection of a mixed media communication format comprising:

a network (Fig. 4); and

a controller (Fig. 4; element 48) coupled to the network (*see Fig. 4 for connection details*), the controller configured to determine the format of a call from a call originator, to determine a selected format of the call for a call recipient based on selection conditions of the call recipient, to convert the format of the call to the

selected format when the format of the call from the call originator does not match the selected call format of the call for the call recipient, and to send the call in the selected format to the call recipient (*PCI Server 48 and its functionalities are discussed at col. 8, line 31 to col. 17, line 11 and thereafter to include how to handle incoming call based on subscriber's profile as well as converting text to speech or vice versa*).

As per **claim 20**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller converts the format of the call by sending a media format negotiation signal to the call originator to prompt the call originator to change the format of the call based on the selected format (*col. 31, lines 14-65*).

As per **claim 21**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller is further configured to determine the format of the call based on a call recipient communication device capability of supporting specific types of media (*col. 32, lines 48-67*).

As per **claim 22**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses wherein the controller is further configured to determine the format for the incoming call based on a current system capacity (*col. 32, lines 46-47*).

As per **claim 23**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses PCI server 48 also translates the wireless text message into speech and plays it back to the caller.

As per **claim 24**, the sending of background noise or comfort noise while a

Art Unit: 2616

mobile waiting for a response is inherent in wireless communication system. This is a practical way to inform a subscriber that the system is functioning normally.

As per **claim 25**, in addition to features recited in base claim 19 (see rationales discussed above), Pepe further discloses PCI server 48 also translates the wireless text message into speech and plays it back to the caller. This also holds true for converting the text message into an audio or voice message should the subscriber choose the audio or speech as a preferred format for receiving the incoming call.

As per **claims 26-27**, the predetermined call command options are discussed at col. 31, lines 22-65. This feature allows a subscriber to have the calls to be properly routed.

As per **claim 28**, a call messaging option is discussed at col. 31, lines 5-21 to include informing the calling party should the call cannot be made at that moment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Titmuss et al (USP 6,167,122) (hereinafter "Titmuss").

As per **claim 15**, in accordance with Pepe reference entirety, Pepe discloses a method (Fig. 24 and col. 30, lines 28-56) of selection of a mixed media communication format at a portable communication device (30, 32 or 34) when receiving a signal of an incoming call, the method comprising: receiving, by the portable communication device, a signal of an incoming call (*col. 30, lines 40-41, Pepe discloses subscriber Mary is notified of an incoming call*); determining, by the portable communication device, a preferred format of the incoming call (*col. 30, lines 45-55, Pepe discloses Mary selects a preferred mode to receive the call*); and sending, by the portable communication device, a media format mode signal indicating the preferred format for the incoming call (*col. 30, lines 45-55, Pepe discloses Mary sends the PCI network her preferred mode of receiving it*), the mixed media communication format including an audio communication format and a text communication format (*col. 23, lines 40-42*). It appears Pepe fails to explicitly further specify "*based on location condition of the portable communication device including a plurality of co-located portable communication devices*" in the determining step. However, such limitation lacks thereof from Pepe is well known and taught by Titmuss.

In an analogous art, Titmuss discloses a method of routing a signal, comprising, among other things, the limitation of "*determining a preferred format of the incoming call based on location condition of the portable communication device including a plurality of co-located portable communication devices*" ('122, Fig. 7 and col. 7, lines 41-50 and thereafter) to provide a storage of capabilities of terminal equipment in the vicinity of a user ('122, col. 2, lines 25-31).

Thus, it would have been obvious to those skilled in the art at the time of the invention to incorporate Titmuss' teaching into Pepe's to arrive the claimed invention with a motivation to provide a storage of capabilities of terminal equipment in the vicinity of a user ('122, col. 2, lines 25-31).

As per **claim 16**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe in view of Titmuss further discloses storing the preferred format for an incoming call on the portable communication device ('905, *downloading profile to PDA 30 is discussed at col. 22, lines 5-7 and thereafter*).

As per **claim 17**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe in view of Titmuss further discloses accepting a user input of media format selection data of a preferred communication format and transmitting the media format selection data to a communication system ('905; *Mary's call treatment sent to PCI network is discussed at col. 30, lines 45-55*).

As per **claim 18**, in addition to features recited in base claim 15 (see rationales discussed above), Pepe in view of Titmuss further discloses displaying a current media format mode on the portable communication device, the current media format



mode including at least one of a current media format input mode and a current media format output mode ('905; *Fig. 31 depicts CallCommand screen*).

### ***Allowable Subject Matter***

6. Claims 1, 3, 5-13, 29, 31-35 and 40-39 are allowed. Should the dependency problem of claims 37-38 be corrected in a response to this Office Action, they are also allowed for the same rationale applied to their base claim.
7. The following is a statement of reasons for the indication of allowable subject matter:  
  
The above claims are allowed for the reason of incorporating the allowable subject matter as discussed in the previous Office Action.

### ***Response to Arguments***

8. Applicant's arguments filed 12/07/07 have been fully considered but they are not persuasive.

In the Remarks of the outstanding response, on page 11, pertaining the amended claims 19-28, Applicants assert the amended claims are in condition for allowance.

In response Examiner respectfully disagrees for the simple rationale discussed above.

Due to the response fails to place the instant application in a favorable condition for allowance, the rejection is maintained.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cave (USP 5,822,404).

Schwelb et al (USP 5,950,123).

Tran (USP 6,496,693).

Zahavi et al (USP 6,577,859).

Mekuria (USP 6,931,255).

Feigenbaum (USP 6,763,089).

Nelson (USP 6,823,184).

Helferich (USP 6,826,407).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank Duong/  
Primary Examiner, Art Unit 2616  
March 02, 2008